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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/917,373

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Cathy S. Beyda

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SIEMENS CORPORATION
Intellectual Property Department
186 Wood Avenue South
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EXAMINER

LE, KAREN L

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,373

Applicant(s)

SIEMENS CORPORATION

Examiner

Karen L. Le

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 6-7 and 14-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-13 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's amendment filed on March 1, 2006 has been entered. No claims have been amended. No claims have been cancelled. No claims have been added. Claims 1-20 are still pending in this application, of the above claims 6-7 and 14-15 are withdrawn from consideration, with claims 1, 13 and 19 being independent. **This action is made final.**

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 8-13 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnard (U. S. 6,859,657).

Regarding claim 1, Barnard teaches a telephone system, comprising:
a telephone including a keyboard and display (Fig. 1, cellular 100, Col. 2, lines 37-42 and Fig. 3, keyboard 3 and display 304) that can make and receive telephone calls; an earpiece (Fig. 2, loudspeaker 118) that provides audio signals from the telephone to an ear of a user; and a microphone (Fig. 2, microphone 114) that receives voice signals

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from the user and provides them to the telephone, where each of the earpiece and microphone are camouflaged (Fig. 2).

Barnard does not teach a conceal telephone that can be hidden on the user. However Barnard teaches casing 302 (Fig.3, item casing 302) includes the personal communication apparatus 100 (Fig. 1, item 100) that can be hidden on the user by having the user wearing a long sleeve shirt to cover the telephone and that still can make and receive telephone calls. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the user wearing a long sleeve shirt to cover the telephone and the telephone becomes a conceal telephone. Wearing a long sleeve shirt to cover a wristwatch is inherent.

Regarding claim 2, Barnard further teaches each of the telephone, earpiece, and microphone include short-range wireless transceivers for transmitting signals therebetween (Col. 2, lines 11-21).

Regarding claims 4 and 8, Barnard further teaches the earpiece is concealed in an article of jewelry (Fig. 2, item 118 and ring 208), microphone is concealed within an article of jewelry (Fig. 2, microphone 114 and trap 204).

Regarding claim 10, Barnard teaches the concealed telephone wherein the microphone and earpiece are connected to the telephone via a hidden wire (Col. 1, lines 24-31).

Regarding claim 11, Barnard further teaches the telephone is a cellular telephone (Col. 2, lines 37-42).

Regarding claim 12, Barnard further teaches the telephone is a wireless telephone (Col. 2, lines 37-42).

Regarding claim 5, Barnard does not teach the article of jewelry is an earring. However Barnard teaches article of jewelry is a ring or a wrist trap (bracelet). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to mount earpiece and microphone elsewhere on his/her body because where the earpiece and microphone are attached is just an option of user to mount them elsewhere on his/her body.

Regarding claims 3, 13 and 18, Barnard teaches a concealed telephone system, comprising: a telephone including a keyboard and display (Fig. 1, cellular 100, Col. 2, lines 37-42 and Fig. 3, keyboard 3 and display 304) that can make and receive telephone calls;

an earpiece (Fig. 2, speaker 118) that provides audio signals from the telephone to an ear of a user, and

a microphone (Fig. 2, microphone 114) that receives voice signals from the user and provides them to the telephone, wherein each of the telephone, earpiece, and

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microphone include short-range wireless transceivers (Col. 2, lines 11-21) for transmitting signals therebetween.

Barnard does not teach a pair of glasses and an earpiece being integrated within a sidepiece of said pair of glasses. However, Barnard teaches an earpiece is integrated within a ring. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to mount earpiece elsewhere on his/her body because where the earpiece are attached is just an option of user to mount them elsewhere on his/her body.

Regarding claim 16, Barnard further teaches microphone is concealed within an article of jewelry (Fig. 2, microphone 114 and trap 204).

Regarding claim 19, Barnard teaches a concealed telephone system, comprising: a telephone including a keyboard and display (Fig. 1, cellular 100, Col. 2, lines 37-42 and Fig. 3, keyboard 3 and display 304) that can make and receive telephone calls;

a bracelet (Fig. 2, trap 204)

an earpiece (Fig. 2, speaker 118) that provides audio signals from the telephone to an ear of a user, and

a microphone (Fig. 2, microphone 114) that receives voice signals from the user and provides them to the telephone, said microphone being integrated within said bracelet (Fig. 2, microphone 114 and trap 204), wherein each of the telephone,

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earpiece, and microphone include short-range wireless transceivers (Col. 2, lines 11-21) for transmitting signals therebetween.

Barnard does not teach said earpiece being integrated within an earring. However, Barnard teaches an earpiece is integrated within a ring. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to mount earpiece elsewhere on his/her body because where the earpiece are attached is just an option of user to mount them elsewhere on his/her body.

4. Claims 9, 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnard (U. S. 6,859,657) in view of Taenzer et al (U. S. 6,438,245).

Regarding Barnard 9, 17 and 20, Barnard does not teach the concealed telephone of Barnard 1, wherein the telephone provides the ambient noise picked up by the microphone to the earpiece when the telephone is not in use. However, Taenzer teaches telephone provides the ambient noise picked up by the microphone to the earpiece when the telephone is not in use (col. 3, lines 13-15). Taenzer teaches a two-way communication earpiece for use with a hearing aid, including a microphone for picking up sound ambient to the earpiece. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Taenzer's feature to Barnard's feature to provide ambient noise picked up by the microphone when the phone is not in use.

Response to Arguments

5. Applicant's arguments filed on March 1, 2006 have been fully considered but they are not persuasive.

As to Applicant's Remarks, Applicant mainly argues that Barnard only teaches two elements of the communication device, an earpiece and microphone and fails to disclose a telephone, operable to make and receive telephone calls, separate from the microphone and earpiece of the communication device. Examiner respectfully disagree for the following reasons: Barnard does teaches three elements of communication device; an earpiece (Fig. 2, earpiece 118 and ring 208), a microphone (Fig. 2, microphone 114 and trap 204) and a telephone (Fig. 3, casing 302 that includes personal communication device 100 shown in figure 1). The personal communication device 10 does make and receive telephone calls (Col. 2, lines 37-42). Furthermore, it has been held for many years that the separation or integration of components/functions would be obvious and does not rise to the level of patentability. *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965). Thus, a telephone operable to make and receive telephone calls, separate from the microphone and earpiece of the communication device does not rise to the level of patentability. For the above reasons, Barnard is maintained for supporting the enclosed Examiner's final action.

Conclusion

5. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen L. Le whose telephone number is 571-272-7487. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing F. Chan can be reached on 571-272-7493. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

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Customer Service Representative or access to the automated information system, call
800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Karen Le
KLL
May 26, 2006



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